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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,414	09/25/2003	Kiyoshi Takeuchi	0234-0469P	5068

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EXAMINER

POWERS, FIONA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/669,414	TAKEUCHI ET AL.	
	Examiner	Art Unit	
	Fiona T. Powers	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-7 is/are rejected.
- 7) ☒ Claim(s) 2 and 8-15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/5/04, 9/23/04, 9/25/04</u> | 6) <input type="checkbox"/> Other: ____. |

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Receipt is acknowledged of the information disclosure statements filed May 5, 2004, September 23, 2004 and September 25, 2004, which have been entered in the file.

Claims 2 and 5 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In claims 2 and 5, R_{41} is a secondary or tertiary alkyl group and the group which corresponds to R_{41} which is R_4 in claims 1 and 4, respectively, is a primary alkyl group. To overcome this objection it is suggested that claims 2 and 5 be put into independent form.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 2, 5, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeuchi et al. (EP 1246006), cited by applicants.

The reference discloses the claimed coupler and silver halide color photographic light sensitive material where the coupler is of the formula (IA) or (IIA) wherein R_1 and R_2 are a substituent, X is a group capable of being split-off upon a coupling reaction with an oxidized product of a developing agent, R_{41} is a secondary alkyl group and Q is $-C(R_{11})=C(R_{12})-SO_2-$ in which R_{11} and R_{12} together with $-C=C-$ form a 6-membered ring and m is 1. Note coupler (169) on page 60 and page 3, lines 5 to 8.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi et al. (EP 1246006).

Determination of the scope and content of the prior art (MPEP §2141.01)

The reference discloses a structurally similar compound which is useful as a dye-forming coupler for a silver halide

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color photographic light sensitive material. The compound disclosed by the reference is structurally similar to the claimed compound of the formula (IA) or (IIA) wherein R_1 and R_2 are a substituent, X is a group capable of being split-off upon a coupling reaction with an oxidized product of a developing agent, R_{41} is a secondary alkyl group and Q is $-C(R_{11})=C(R_{12})-SO_2-$ in which R_{11} and R_{12} together with $-C=C-$ form a 6-membered ring and m is 1. Note coupler (169) on page 60 and page 3, lines 5 to 8.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The coupler of the reference differs from the claimed coupler only in that a secondary alkyl group replaces the primary alkyl group represented by R_4 .

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2413)

It would have been obvious to one of ordinary skill in the art to replace the secondary alkyl group of the reference coupler with a primary alkyl group with the expectation that additional compounds useful as couplers would be obtained. The claimed coupler and silver halide color photographic light sensitive material would have been rendered obvious by the structurally similar coupler of the reference in the absence of any unobvious property.

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Claims 3 and 8 to 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

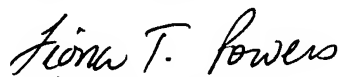
The references made of record and not relied upon show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Fiona T. Powers
Primary Examiner
Art Unit 1626

ftp
March 16, 2005